



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,660	03/15/2004	Ryan D. Bruncau	IMMR-0101A	8598
60140 7590 03/30/2007 IMMERSION -THELEN REID BROWN RAYSMAN & STEINER LLP P.O. BOX 640640 SAN JOSE, CA 95164-0640			EXAMINER LESPERANCE, JEAN E	
			ART UNIT 2629	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/799,660	Applicant(s) BRUNEAU ET AL.	
	Examiner Jean E. Lesperance	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The application filed March 15, 2004 is presented for examination and claims 28-61 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 2629

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,707,443. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat a broader recitation of '443 Patent. For instance, in claims 28, 39, 49, and 51 of the present claimed invention and claims 1, 14, 25, and 28 of the '443 Patent, the applicant claims:

Regarding claims 28 and 49, the present invention claims "configured to output haptic feedback approximately along an axis that is substantially normal to a point of the sphere extending from the housing" whereas the '443 Patent claims in claims 1 and 25 "configured to output haptic feedback to the housing approximately along an axis that is substantially perpendicular to the support surface".

Thus, with respect to the above discussions, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to figure out that "an axis that is substantially normal to a point of the sphere extending from the housing" of the present invention has the same function as "an axis that is substantially perpendicular to the support surface" of the '443 patent because when the user is in contact with the rotatable sphere, the force applied by the user is extending from the

Art Unit: 2629

housing and that same force is perpendicular to the support surface which is under the housing.

Regarding claim 39, the present invention claims "a housing" whereas the '443 patent claims in claim 14 "a housing having a base configured to contact a support surface".

Thus, with respect to the above discussions, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to know that this particular housing must have a base that is in contact with the support surface in order for user to operate it.

Regarding claim 51, the present invention claims "a sphere" whereas the '443 Patent claims in claim 28 "a sphere positioned in the housing".

Thus, with respect to the above discussions, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to know that a sphere can not function on its own by needs a housing in order to be operated upon.

The instant claims obviously encompass the claimed invention of the '443 Patent and differ only in terminology and broader steps. The extent that the instant claims are broaden and therefore generic to claimed invention of the '443 Patent [species], In a Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim can not be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

Allowable Subject Matter

Art Unit: 2629

3. Claims 28-61 are allowed over the Prior Art.

4. The following is an examiner's statement of reasons for allowance: the claimed invention is directed to a user interface systems apparatus.

Independent claim 28 identifies a uniquely distinct feature "an actuator coupled to the housing and configured to output haptic feedback approximately along an axis that is substantially normal to a point of the sphere extending from the housing, the haptic feedback being based on the sensor signals".

Independent claim 39 identifies a uniquely distinct feature "an at least one compliant element coupled to the housing, the at least one compliant element being configured to amplify the haptic feedback".

Independent claim 49 identifies a uniquely distinct feature "receiving a second signal from the host computer, the second signal being associated with a simulated interaction or event occurring within a graphical environment and outputting haptic feedback based on the second signal, the haptic feedback being output approximately along an axis substantially normal to a point of the extended portion of the sphere".

Independent claim 51 identifies a uniquely distinct feature "an actuator configured to output haptic feedback approximately along an axis that is substantially linear to an extended portion of the sphere, the haptic feedback being based on the sensor signals".

None of the prior arts, either singularly or in combination, fails to anticipate or render obvious the above limitations obvious.

Conclusion

Art Unit: 2629

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Lesperance whose telephone number is (571) 272-7692. The examiner can normally be reached on from Monday to Friday between 10:00AM and 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (571) 272-7691.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for Technology Center 2600 only)

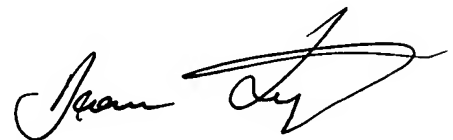
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Jean Lesperance

Art Unit 2629

Date 3/29/2007

A handwritten signature in black ink, appearing to read 'Jean Lesperance', with a stylized flourish at the end.